

IN THE U.S. PATENT AND TRADEMARK OFFICE

AF #23
EP
5/11/05

In re Application of

Gerard Chauvel, et al.

TI-15767A.1

Art Unit: 2186

Serial No.: 09/606,057

Examiner: Tran

Filed: 06/28/2000

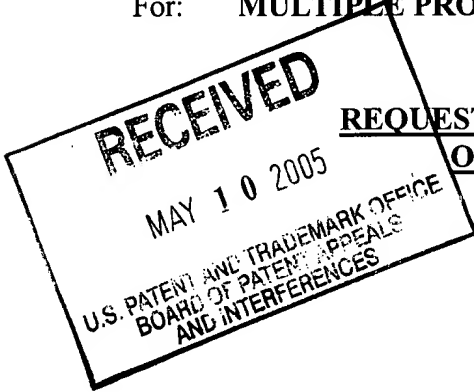
Conf. No.: 8397

For: MULTIPLE PROCESSOR CELLULAR RADIO

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APR 07 2005

Technology Center 2100

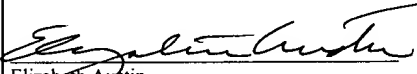


REQUEST FOR REHEARING/RECONSIDERATION
OF BOARD OF APPEALS DECISION

TRANSMITTAL LETTER

Assistant Commissioner for Patents

Alexandria, VA 22313-1450

<u>MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8 (A)</u>	
I hereby certify that on this day this correspondence is being deposited with the US Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450.	
	3-31-2005
Elizabeth Austin	Date

Dear Sir:

Transmitted herewith in triplicate is a Request Pursuant to 37 CFR 1.197(b) for Rehearing/Reconsideration of Board of Appeals Decision in the above-identified application.

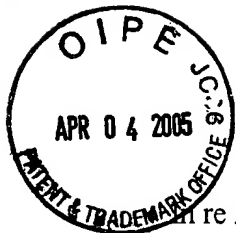
Charge any additional fees, or credit overpayment to the deposit account of Texas Instruments Incorporated, Account No. 20-0668. An original and two copies of this sheet are enclosed.

Respectfully submitted,



Ronald O. Neerings
Attorney for Applicant
Registration No. 34,227

Texas Instruments Incorporated
P. O. Box 655474, M.S. 3999
Dallas, Texas 75265
(972) 917-5299



IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Application of

Gerard Chauvel, et al.

Serial No.: 09/606,057

Filed: 06/28/2000

For: MULTIPLE PROCESSOR CELLULAR RADIO

TI-15767A.1

Art Unit: 2186

Examiner: Tran

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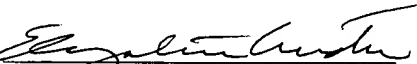
REQUEST FOR REHEARING/RECONSIDERATION
OF BOARD OF APPEALS DECISION

TRANSMITTAL LETTER

Assistant Commissioner for Patents

Alexandria, VA 22313-1450

Dear Sir:

<u>MAILING CERTIFICATE UNDER 37 C.F.R. § 1.18 (A)</u>	
I hereby certify that on this day this correspondence is being deposited with the US Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450.	
 Elizabeth Austin	3-31-2005 Date

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Respectfully submitted,



Ronald O. Neerings
Attorney for Applicant
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Texas Instruments Incorporated
P. O. Box 655474, M.S. 3999
Dallas, Texas 75265
(972) 917-5299

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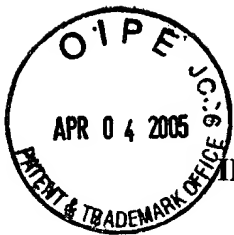
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COMMUNICATIONS SECTION

APR 18 AM 11:29



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Chauvel

Serial No.: 09/606,057

Filed: 06/28/00

For: **MULTIPLE PROCESSOR CELLULAR RADIO**

TI-15767A.1

Art Unit: 2816

Examiner: **Tran**

Conf. No.: 8397

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APR 07 2005

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REQUEST PURSUANT TO 37 CFR 1.197(b) FOR REHEARING/RECONSIDERATION
OF BOARD OF APPEALS DECISION

Assistant Commissioner of Patents

Alexandria, VA 22313-1450

MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8(a)

I hereby certify, that on this date, this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450.

Elizabeth Austin
Elizabeth Austin

March 31, 2005
Date

Dear Sir:

This paper is filed (in triplicate) in response to the Board of Appeals Decision mailed on January 31, 2005. Please charge any fees required by this paper to the deposit account of Texas Instruments Incorporated, Deposit Account No. 20-0668.

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2005 APR 03 AM 11:29
BOARD OF APPEALS
AND INTERFERENCES

INTRODUCTION

Appellants hereby respectfully request reconsideration of the aforementioned decision of the Board of Appeals for the following reasons:

- 1) The Board erred by determining that Paneth discloses a cellular radio and by relying upon the definition of a "cellular radio" from encyclopedia.com attached by the Board to the Decision on Appeal to justify its determination.
- 2) The Board erred by not designating its determination that Paneth discloses a cellular radio, which is not consistent with the Examiner's determination, a new grounds of rejection.
- 3) The Board erred by determining that elements 17 and 20 together, as disclosed in Figure 2 of Paneth, together form a first, main processor of the cellular radio system.
- 4) The Board erred by not designating its determination that Paneth's elements 17 and 20 are the equivalent to Appellants first, main, processor, which is not consistent with the Examiner's determination, a new grounds of rejection.
- 5) The Board committed error by erroneously determining that Paneth teaches a processor 33 positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor).
- 6) The Board erred by not designating its determination that Paneth's teaches a processor 33 positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor), which is not consistent with the Examiner's determination, a new grounds of rejection.
- 7) The Board committed error by erroneously determining that Claesson discloses an array being intended for a hands-free mobile radio telephone which suggest using the array in a cellular environment.
- 8) The Board erred by not designating its determination that Claesson teaches that its mobile radio telephones are cellular radios, which is not consistent with the Examiner's determination, a new grounds of rejection.

ARGUMENT

- 1) The Board erred by determining that Paneth discloses a cellular radio and by relying upon the definition of a "cellular radio" from encyclopedia.com attached by the Board to the Decision on Appeal to justify its determination.

The Board determined in its Decision, contrary to the determination of the Examiner, that Paneth discloses a cellular radio. More particularly, the Board determined:

After a careful reading of Paneth we find that, notwithstanding the examiner's statements to the contrary (Answer, page 3), Paneth discloses a cellular radio because Paneth discloses (in the abstract) a "telecommunication system for processing a plurality of simultaneous bidirectional communications . . . using wireless transmission over one of plurality of available RF carrier frequencies," **which is, by definition, a cellular telephone and cellular radio.** (See attached definition of "cellular telephone" from encyclopedia.com wherein "cellular telephone" and "cellular radio" are considered alternatives for each other.") Thus, the use of Barnes for a teaching of a cellular radio is merely cumulative, and arguments regarding motivation to combine the two references are regarded as being moot (Decision on Appeal, page 5, line 19 – page 6, line 9).

Appellants respectfully respond that the Board in its determination above ignored the further teaching in the definition of "cellular telephone" from encyclopedia.com that the transmitter and receiver are linked via **microwave radio frequencies**. Nowhere does Paneth teach or suggest that the RF frequencies that it uses are "microwave" frequencies.

Moreover, while Paneth discloses a local-loop telephone service using UHF radio between subscriber station (S) 10 and a base station (col. 6, lines 7-14), nowhere does Paneth teach or suggest that its subscriber stations can work with more than one base station OR that its base stations are divided into "cells", each cell having a central base station and two sets of assigned

transmission frequencies, one set used by the base station and the other used by mobile telephones, as is further required by the definition supplied by, and relied upon, by the Board. Indeed, Paneth, to the contrary, teaches the following:

Referring to FIG. 1, the system of the present invention provides **local-loop telephone service** using UHF radio between subscriber stations (s) 10 and a base station 11. The base station 11 provides call connections directly between the radio-based subscriber stations 10 and is connected to a telephone company (Teleco) central office 12 for calls to or from points outside the system (Col. 6, lines 8-14).

Accordingly, Paneth discloses "local-loop telephone service" – there is no teaching whatsoever in Paneth that its system can be applied to cellular communications. One of ordinary skill in the art would recognize that local-loop telephone service is SMR - NOT Cellular. The local-loop telephone service disclosed by Paneth is sort of like a home based portable telephone on steroids. In no event, however, does Paneth disclose a cellular system. The Board's determination is erroneous and should be withdrawn.

- 2) The Board erred by not designating its determination that Paneth discloses a cellular radio, which is not consistent with the Examiner's determination, a new grounds of rejection

The Board admits in its Decision on Appeal that its determination that Paneth discloses a "cellular radio" is not consistent with the determination of the Examiner:

After a careful reading of Paneth we find that, notwithstanding the examiner's statements to the contrary (Answer, page 3), Paneth discloses a cellular radio because Paneth discloses (in the abstract) a "telecommunication system for processing a plurality of simultaneous bidirectional communications . . . using wireless transmission over one of plurality of available RF carrier frequencies,"

which is, by definition, a cellular telephone and cellular radio. (See attached definition of “cellular telephone” from encyclopedia.com wherein “cellular telephone” and “cellular radio” are considered alternatives for each other.”) Thus, the use of Barnes for a teaching of a cellular radio is merely cumulative, and arguments regarding motivation to combine the two references are regarded as being moot (Decision on Appeal, page 5, line 19 – page 6, line 9).

By replacing the Examiner’s determination that Paneth does not disclose a “cellular radio” with its own determination that Paneth DOES disclose a “cellular radio”, and by relying upon a document (the encyclopedia.com definition attached to the Decision by the Board) not before the Examiner to support its determination, the Board adopted new technical facts. The Board’s action qualifies as a new ground of rejection. In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971); In re Ahlert, 424 F.2d 1088, 1092, 165 USPQ 418 (CCPA 1970); In re Spormann, 363 F.2d 444, 447, 150 USPQ 449 (CCPA 1966); In re Oku, 25 USPQ2d 1155, 1157 (Comm’r Pat. & Trademarks 1992)(reliance for first time on appeal on the specification’s description of the prior art “constitutes a new basis for refusing a patent and petitioner has not had an adequate opportunity to respond to the precise basis upon which the rejection is based.”). Since the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board’s opinion labels the ground as “new”. In re Waysmouth, 486 F.2 1058, 1060-1061, 179 USPQ 627 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1371, 178 USPQ 470 (CCPA 1973); In re Echerd, 471 F.2d 632, 635, 176 USPQ 321 (CCPA 1973); In re Ludtke, 441 F.2d 660, 662, 169 USPQ 563 (CCPA 1971); In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965); Ex parte Hagenan, 179 USPQ 747, 751 (Bd. Pat. App. 1972).

Even if, arguendo, the Board did not adopt new technical facts in applying different teaching to Paneth, the Board adopted a new theory for the rejection in applying different teaching to Paneth, which also qualifies the Board's action as a new grounds of rejection. In re De Blauwe, 736 F.2d 699, 706 n.9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984), ("Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence."). As above, if the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board agrees that the ground is "new" or its opinion labels the ground as "new". If the new rejection is not stated to be under Rule 196(b), Appellants are not provided with the opportunity to submit contradictory evidence as required by In re De Blauwe.

As a result, the Board erred by not designating its determination that Paneth discloses a "cellular radio", which is not consistent with the Examiner's determination, a new grounds of rejection.

- 3) The Board erred by determining that elements 17 and 20 together, as disclosed in Figure 2 of Paneth, together form a first, main processor of the cellular radio system.

The Board determined in its Decision, contrary to the determination of the Examiner, that Paneth's elements 17 and 20 TOGETHER are the equivalent of Appellants' main processor. More particularly, the Board determined:

As to the limitation of a first processor being a "main processor," we consider Paneth's elements 17 and 20 together as shown in Figure 2. ... Accordingly, elements 17 and 20 together form a first, main processor of the cellular radio system (Decision on Appeal, page 6, line 10 – page 7, line 2).

Appellants respectfully respond that the Board has misinterpreted Figure 2. Figure 2 clearly shows, contrary to the Board's determination, that there is no direct connection between voice codec unit 17 and remote connection processor 20. Indeed, it is channel control unit 18 that couples voice codec unit 17 to remote connection processor 20. Being that the Board determined channel control unit 18 is equivalent to Appellants' second processor how is it technically or logically possible for the Board to determine that VCC 17 and RPU 20 are one processor when they are coupled together ONLY by a second processor 18? Pull out CCU 18 from Figure 2 and VCU 17 and RPU 20 cannot communicate with each other or perform their respective tasks. Appellants respectfully submit that the Board is using selectively picking and choosing elements within Paneth to obviate Appellants' invention, which is not proper.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is also impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985). Moreover, the CAFC has stated that **"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."** In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The Board's determination that Paneth's elements 17 and 20 are the equivalent of Appellants' first or main processor is erroneous and should be withdrawn.

- 4) The Board erred by not designating its determination that Paneth's elements 17 and 20 are the equivalent to Appellants first, main, processor, which is not consistent with the Examiner's determination, a new grounds of rejection.

The Examiner determined:

Paneth teaches the processor 20 is not only the central control (i.e., dominant control or most control) processor but also the most important control processor because it performs the system management functions, controls the other elements, such as processor 18 (col. 8, lines 23-25), modem 19, RFU 21 (col. 8, lines 44-47), control mechanism for call set up, teardown, and maintenance, and control the interconnection between codecs 16 and the Telco trunks. **Therefore, Paneth teaches the processor is the main processor of the base or the radio.** (Examiner's Answer, page 9, line 18 – page 10, line 5).

The Board, however, determined in its Decision, contrary to the determination of the Examiner, that Paneth's elements 17 and 20 TOGETHER are the equivalent of Appellants' main processor. More particularly, the Board determined:

As to the limitation of a first processor being a "main processor," we consider Paneth's elements 17 and 20 together as shown in Figure 2. ... Accordingly, elements 17 and 20 together form a first, main processor of the cellular radio system (Decision on Appeal, page 6, line 10 – page 7, line 2).

By replacing the Examiner's determination that Paneth's element 20 alone is equivalent to Appellants' first or main processor with its own determination that Paneth's elements 17 and 20 TOGETHER are the equivalent to Appellants' first or main processor, the Board adopted new technical facts in its Decision. The Board's action qualifies as a new ground of rejection. In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971); In re Ahlert, 424 F.2d 1088, 1092, 165 USPQ 418 (CCPA 1970); In re Spormann, 363 F.2d 444, 447, 150 USPQ 449 (CCPA 1966); In re Oku, 25 USPQ2d 1155, 1157 (Comm'r Pat. & Trademarks 1992)(reliance for first time on appeal on the specification's description of the prior art "constitutes a new basis for refusing a patent and petitioner has not had an adequate opportunity to respond to the precise basis upon which the rejection is based."). Since the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires

that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board's opinion labels the ground as "new". In re Waysmouth, 486 F.2 1058, 1060-1061, 179 USPQ 627 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1371, 178 USPQ 470 (CCPA 1973); In re Echerd, 471 F.2d 632, 635, 176 USPQ 321 (CCPA 1973); In re Ludtke, 441 F.2d 660, 662, 169 USPQ 563 (CCPA 1971); In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965); Ex parte Hagenan, 179 USPQ 747, 751 (Bd. Pat. App. 1972).

Even if, arguendo, the Board did not adopt new technical facts in applying different teaching to Paneth, the Board adopted a new theory for the rejection in applying a different combination of elements within Paneth to obviate Appellants' invention, which also qualifies the Board's action as a new grounds of rejection. In re De Blauwe, 736 F.2d 699, 706 n.9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984), ("Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence."). As above, if the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board agrees that the ground is "new" or its opinion labels the ground as "new". If the new rejection is not stated to be under Rule 196(b), Appellants are not provided with the opportunity to submit contradictory evidence as required by In re De Blauwe.

As a result, the Board erred by not designating its determination that elements 17 and 20 TOGETHER are the equivalent of Appellants' first or main processor, which is not consistent with the Examiner's determination, a new grounds of rejection.

- 5) The Board committed error by erroneously determining that Paneth teaches a processor 33 positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor).

The Board made the following determination in its Decision on Appeal:

Appellants contend (Reply Brief, pages 12-13) that the examiner “points to no teaching [sic, or] suggestion in Paneth that supports his determination that diversity combiner 33 ... ‘reads on the processor performing signal processor [sic, processing] on vectors limitation on [sic, in] the claim.’” However, Paneth (column 71, lines 42-47, and Figures 2 and 3) teaches a processor 33 **positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18** (the claimed second processor) (Decision, page 7, lines 9-17).

Paneth’s Figure 2, which is a block diagram of a representative preferred embodiment of a base station in the system of Figure 1 (col. 3, lines 57-58 & col. 7, lines 46-47) does not show or teach a diversity combiner 33. In figure 2, modem 19 is directly connected to CCU 18, which is directly connected to VCU 17. CCU 18 is further directly connected to RPU 20. Figure 3, on the other hand, is a block diagram of a preferred embodiment of a subscriber station in the system of Figure 1. Figure 3 discloses that CCU 29 couples VCU 28 to Modem 30a. While diversity combiner 33 is peripherally connected to both CCU 29 and modem 30a it does not couple any of elements 28, 29 and 30a together. Accordingly, the Boards determination that “processor 33 is **positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18** (the claimed second processor) (Decision, page 7, lines 9-17)”, is erroneous and should be withdrawn.

- 6) The Board erred by not designating its determination that Paneth's teaches a processor 33 positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor), which is not consistent with the Examiner's determination, a new grounds of rejection.

The Board made the following determination in its Decision on Appeal:

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Where, however, is the Examiner's determination that Paneth (column 71, lines 42-47, and Figures 2 and 3) teaches a processor 33 **positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor)**? Appellants could find no such teaching.

By setting forth its own determination that that Paneth (column 71, lines 42-47, and Figures 2 and 3) teaches a processor 33 **positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18 (the claimed second processor)**, the Board adopted new technical facts in its Decision. The Board's action qualifies as a new ground of rejection. In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971); In re Ahlert, 424 F.2d 1088, 1092, 165 USPQ 418 (CCPA 1970); In re Spormann, 363 F.2d 444, 447, 150 USPQ 449 (CCPA 1966); In re Oku, 25

USPQ2d 1155, 1157 (Comm'r Pat. & Trademarks 1992)(reliance for first time on appeal on the specification's description of the prior art "constitutes a new basis for refusing a patent and petitioner has not had an adequate opportunity to respond to the precise basis upon which the rejection is based."). Since the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board's opinion labels the ground as "new". In re Waysmouth, 486 F.2 1058, 1060-1061, 179 USPQ 627 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1371, 178 USPQ 470 (CCPA 1973); In re Echerd, 471 F.2d 632, 635, 176 USPQ 321 (CCPA 1973); In re Ludtke, 441 F.2d 660, 662, 169 USPQ 563 (CCPA 1971); In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965); Ex parte Hagenan, 179 USPQ 747, 751 (Bd. Pat. App. 1972).

Even if, arguendo, the Board did not adopt new technical facts in applying different teaching to Paneth, the Board adopted a new theory for the rejection in applying a different combination of elements within Paneth to obviate Appellants' invention, which also qualifies the Board's action as a new grounds of rejection. In re De Blauwe, 736 F.2d 699, 706 n.9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984), ("Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence."). As above, if the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board agrees that the ground is "new" or its opinion labels the ground as "new". If the new rejection is not stated to be under Rule 196(b), Appellants are not provided with the opportunity to submit contradictory evidence as required by In re De Blauwe.

According, the Board erred by not designating its determination that that Paneth (column 71, lines 42-47, and Figures 2 and 3) teaches a processor 33 **positioned between modem 19 and CCU 18 and coupled to elements 17 and 20 (the claimed first processor) through element 18** (the claimed second processor), which is not consistent with the Examiner's determination, a new grounds of rejection.

- 7) The Board committed error by erroneously determining that Claesson discloses an array being intended for a hands-free mobile radio telephone which suggest using the array in a cellular environment.

The Board made the following determination in its Decision on Appeal:

Appellants conclude (Brief, page 23) that it would not have been obvious "to have re-engineered the DSP900 ... [to] be a cellular radio, ..., without the improper hindsight provided by Appellants' disclosure." However, as indicated by the excerpt from encyclopedia.com, Claesson's **mobile radio telephones are cellular radios**. Thus, Claesson's disclosure of the array being intended for a hands-free mobile radio telephone **suggests using the array in a cellular radio** (Decision, page 9, lines 14-21).

As with other determinations of the Board identified above, the Board's determination that Claesson discloses mobile radio telephones that are cellular radios is not consistent with the determination of the Examiner. The Examiner admitted in his Office Action dated December 20, 2001, that "Claesson does not show the use of cellular" (Office Action dated December 20, 2001 page 7, line 2). Appellants respectfully submit the Board has made the same error relying upon encyclopedia.com definition to determine that Claesson suggests a cellular radio that it did in using the definition to determine that Paneth discloses a cellular radio. Using the Board's determination,

any RF two-way radio could be considered a “cellular radio or telephone”. Such determination is simply erroneous and should be withdrawn.

The encyclopedia.com definition adopted by the Board in its Decision states the following:

... cellular radio, telecommunications system I which a portable or mobile radio transmitter and receiver, or “telephone,” is **linked via microwave radio frequencies to base transmitter and receiver stations** that connect the user to a convention telephone network. The **geographic region served by a cellular system is subdivided into areas called cells. Each cell has a central base station and two sets of assigned transmission frequencies; one set is used by the base station, and the other by mobile telephones.** To prevent radio interference, **each cell uses frequencies different from those used by its surrounding cells, but cells sufficiently distant from each other can use the same frequencies.** When a **mobile telephone leaves one cell and enters another, the telephone call is transferred from one base station and set of transmission frequencies to the next using a computerized switching system** (Encyclopedia.com article submitted by the Board in its Decision).

Where is there any teaching in Claesson that it RF frequencies are **linked via microwave radio frequencies to base transmitter and receiver stations**, as required by the above definition?

Where is there any teaching in Claesson that it has a **geographic region served by a cellular system is subdivided into areas called cells. Each cell has a central base station and two sets of assigned transmission frequencies; one set is used by the base station, and the other by mobile telephones**, as further required by the above definition? Where is there any teaching in Claesson that when a **mobile telephone leaves one cell and enters another, the telephone call is transferred from one base station and set of transmission frequencies to the next using a computerized switching system**, as yet further required by the above definition of a cellular system? There is no such teaching in Claesson. The Board’s determination is supposition not supported by fact, and as such, it is erroneous and should be withdrawn.

- 8) The Board erred by not designating its determination that Claesson teaches that its mobile radio telephones are cellular radios, which is not consistent with the Examiner's determination, a new grounds of rejection.

The Examiner admitted in his Office Action dated December 20, 2001, that "Claesson does not show the use of cellular" (Office Action dated December 20, 2001 page 7, line 2).

The Board, however, made the following determination in its Decision on Appeal:

Appellants conclude (Brief, page 23) that it would not have been obvious "to have re-engineered the DSP900 ... [to] be a cellular radio, ..., without the improper hindsight provided by Appellants' disclosure." However, as indicated by the excerpt from encyclopedia.com, Claesson's **mobile radio telephones are cellular radios**. Thus, Claesson's disclosure of the array being intended for a hands-free mobile radio telephone **suggests using the array in a cellular radio** (Decision, page 9, lines 14-21).

By setting forth its own determination that that Claesson discloses **mobile radio telephones are cellular radios** and further determining that Claesson's disclosure of the array being intended for a hands-free mobile radio telephone **suggests using the array in a cellular radio**, the Board adopted new technical facts in its Decision. The Board's action qualifies as a new ground of rejection. In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971); In re Ahlert, 424 F.2d 1088, 1092, 165 USPQ 418 (CCPA 1970); In re Spormann, 363 F.2d 444, 447, 150 USPQ 449 (CCPA 1966); In re Oku, 25 USPQ2d 1155, 1157 (Comm'r Pat. & Trademarks 1992)(reliance for first time on appeal on the specification's description of the prior art "constitutes a new basis for refusing a patent and petitioner has not had an adequate opportunity to respond to the precise basis upon which the rejection is based.")). Since the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural

fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board's opinion labels the ground as "new". In re Waysmouth, 486 F.2 1058, 1060-1061, 179 USPQ 627 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1371, 178 USPQ 470 (CCPA 1973); In re Echerd, 471 F.2d 632, 635, 176 USPQ 321 (CCPA 1973); In re Ludtke, 441 F.2d 660, 662, 169 USPQ 563 (CCPA 1971); In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965); Ex parte Hagenan, 179 USPQ 747, 751 (Bd. Pat. App. 1972).

Even if, arguendo, the Board did not adopt new technical facts in applying different teaching to Claesson that the Examiner, the Board adopted a new theory for the rejection in applying a different combination of elements within Claesson to obviate Appellants' invention, which also qualifies the Board's action as a new grounds of rejection. In re De Blauwe, 736 F.2d 699, 706 n.9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984), ("Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence."). As above, if the Board in fact entered a new ground for rejection in its Decision on Appeal, procedural fairness requires that Applicants be accorded the rights provided in Rule 196(b) whether or not the Board agrees that the ground is "new" or its opinion labels the ground as "new". If the new rejection is not stated to be under Rule 196(b), Appellants are not provided with the opportunity to submit contradictory evidence as required by In re De Blauwe.

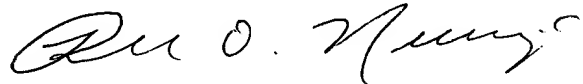
According, the Board erred by not designating its determination that that Claesson discloses **mobile radio telephones that are cellular radios** - thus, Claesson's disclosure of the array being

intended for a hands-free mobile radio telephone **suggests using the array in a cellular radio**, which is not consistent with the Examiner's determination, a new grounds of rejection.

In light of the above, Appellants have shown error in the Board's basis for affirming the 35 U.S.C. 103 rejection of independent Claims 1, 14, 15 and further applied to those claims depending directly or indirectly therefrom. As such, the affirmance of Claims 6, 8, 10 and 12-21 should be withdrawn.

In view of the foregoing discussion, Appellant requests favorable reconsideration of the Board Decision and a reversal of the 35 U.S.C. § 103 rejection of Claims 6, 8, 10 and 12-21.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Ron O. Neerings".

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